

REMARKS

A. 35 U.S.C. § 102

1. Claims 1-10 and 34-37

In the Office Action mailed on August 14, 2006, claims 1-10 and 34-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hafner et al., U.S. Patent No. 5,893,076. Claim 1 has been canceled, rendering its rejection moot. Claim 7 has been amended so as to be in independent form. In addition, claim 7 recites “the extracting process is selected from the group consisting of a process based on compatibility of a processing system of a second business entity to receive the extracted subset, a process based on previous history of usefulness of prior extracted data, a process based on a model for managing the transactional subject and a process based on properties of the database.” Since Hafner et al. does not disclose any one of the extracting process options recited in claim 7, claim 7 and its dependent claims 2-6, 8-10 and 34-37 are not anticipated by Hafner et al.

The rejection of claim 8 is also traversed in that Hafner et al. does not disclose transmitting superseding requirement-indicating data on an as-needed basis. The passages relied on by the Office Action do not disclose or suggest such transmitting.

The rejection of claim 9 is also traversed in that Hafner et al. does not disclose transmitting differential data for expressing a change with respect to prior requirement indicating data. The passages relied on by the Office Action do not disclose or suggest such transmitting.

Besides not being anticipated by Hafner et al., claim 7 is not rendered obvious by Hafner et al. since there is no suggestion in Hafner et al. or the prior art to alter Hafner et al. to perform the recited extracting process. Without such suggestion, claim 7 should be allowed.

Note that claims 2-6, 8-10, 34 and 36 have been amended so as to depend from claim 7. Since the amendments are solely being made to provide additional coverage for the method of claim 7, the amendments are not being made for reasons related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002) (hereinafter *Festo I*).

As mentioned above, claim 7 has been placed in independent form. To the extent the amendments made to claim 7 incorporate subject matter that was already inherently present in claim 7 prior to the present amendment, the amendment is not related to patentability. *See, Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 535 U.S. 722 (2002) (hereinafter *Festo II*).

2. Claims 11, 12 and 18-22

Claims 11, 12 and 18-22 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hafner et al. Claim 11 has been canceled, rendering its rejection moot. Claims 12 and 18-22 have been amended so as to depend from claim 14, which has been conceded by the Office Action not to be anticipated by Hafner et al. Accordingly, the rejection should be withdrawn.

As mentioned above, claims 12 and 18-22 have been amended so as to depend from claim 14. Since the amendments are solely being made to provide additional coverage for the method of claim 14, the amendments are not being made for reasons related to patentability as defined in *Festo I*.

B. 35 U.S.C. § 103

1. Hafner et al.

Claims 13 and 17 were rejected under 35 U.S.C. § 103 as being obvious in view of Hafner et al. Claims 13 and 17 depend indirectly on claim 14 which has been amended so as to be in independent form. In addition, claim 14 has been amended so as to recite “the extracting process is selected from the group consisting of a process based on compatibility of a processing system of a second business entity to receive the extracted subset, a process based on previous history of usefulness of prior extracted data, a process based on a model for managing the transactional subject and a process based on properties of the database.” Since there is no suggestion in Hafner et al. or the prior art to alter Hafner et al. to perform the recited extracting process, claims 13 and 17 are patentable over Hafner et al.

2. Hafner et al. and Meltzer et al.

Claims 14-16 were rejected under 35 U.S.C. § 103 as being obvious in view of Hafner et al. and Meltzner et al. U.S. Patent No. 6,125,391. Claim 14 has been amended so as to be in independent form. In addition, claim 14 has been amended so as to recite “the extracting process is selected from the group consisting of a process based on

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compatibility of a processing system of a second business entity to receive the extracted subset, a process based on previous history of usefulness of prior extracted data, a process based on a model for managing the transactional subject and a process based on properties of the database.” Hafner et al. does not disclose any one of these extracting options. Since Meltzner et al. does not suggest altering Hafner et al. to perform the recited extracting process, the rejection should be withdrawn.

C. New Claims 38-41

New claims 38-41 are being presented to provide additional coverage for the methods of claims 7 and 14. Accordingly, new claims 38-41 are not being presented for reasons of patentability as defined in *Festo I*.

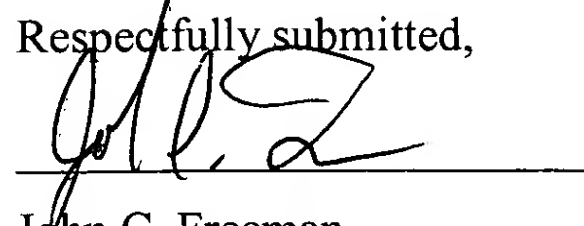
CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 2-10, 12-22 and 34-41 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any

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remaining issues, he is respectfully requested to contact the undersigned attorney at (312)
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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. C. Freeman', is written over a horizontal line.

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